

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JIMMIE G. DEMASTERS

---

Appeal No. 98-0057  
Application No. 08/320,016<sup>1</sup>

---

ON BRIEF

---

Before McCANDLISH, Senior Administrative Patent Judge, COHEN  
and FRANKFORT, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the examiner's final rejection of claims 1 through 8 and 15. The only other claims

---

<sup>1</sup> Application for patent filed October 7, 1994.

Appeal No. 98-0057  
Application No. 08/320,016

still pending in the application have been withdrawn from consideration as being directed to a nonelected invention.

Claim 1, the only independent claim on appeal, defines the invention as follows:

1. A helical pipe comprising an outer plastic layer and an inner plastic layer wherein said outer plastic layer is an ultraviolet light-protective color and said inner plastic layer is [sic, has] a light-reflecting color such that the interior of said helical pipe can be accurately inspected by visual or video means.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Fouss et al. (Fouss)	4,523,613	Jun. 18, 1985
Prassas et al. (Prassas)	5,299,885	Apr. 5, 1994

(filed Aug. 14, 1992)

Appealed claims 1 through 8 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fouss in view of Prassas. Appealed claims 1 through 8 additionally stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which appellant regards as his invention.<sup>2</sup>

The basis for the rejection of claims 1 through 8 under the second paragraph of § 112 involves two limitations in claim 1. The examiner's first difficulty with the claim language centers on the recitation that the outer plastic layer has "an ultraviolet light-protective color." The examiner's second difficulty with the claim language centers on the word "accurately" in the recitation that the inner plastic layer "is [sic, has] a light-reflecting color such that the interior of said helical pipe can be accurately inspected . . ."

In arguing that the claim language is definite, appellant relies on the following definitions presented on page 8 of the specification for the expressions "ultraviolet light-protective color" and "light-reflecting color":

By ultraviolet light-protective color it is meant that the plastic layer has a color and composition sufficient to prevent or retard the deterioration of

---

<sup>2</sup> The examiner has offered no reason why claim 15 was omitted from this rejection, despite the fact that this dependent claim, like claims 2 through 8, is in the chain of dependency from claim 1.

Appeal No. 98-0057  
Application No. 08/320,016

the plastic layer upon exposure to ultraviolet light.... By light-reflecting color it is meant that the color is light enough to provide adequate reflection of light to allow accurate visual or video inspection of the inside of the pipe.

We are not persuaded by appellant's arguments that the rejection of claims 1 through 8 under the second paragraph of § 112 is improper. Although an inventor is free to define specific terms used in a claim to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Neither of the definitions quoted supra meets the Paulsen requirements.

With regard to the expression "accurately inspected" in claim 1 and the expression "accurate . . . inspection" in the above-quoted definition for the phrase "light-reflecting color," it is unclear how thorough the inspection must be in order to be considered as being "accurate." Appellant's specification does not contain any guidelines to enable one skilled in the art to determine what constitutes an "accurate inspection." Compare Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). For these reasons alone, claim 1 does not define the

Appeal No. 98-0057  
Application No. 08/320,016

metes and bounds of the claimed subject matter with a reasonable degree of precision as required in In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

With regard to the expression "ultraviolet light-protective color" the definition as quoted supra, does not make clear the degree to which the outer plastic layer must "retard" the ultraviolet light in order to be considered as being "protective." Furthermore, the specification states that the expression "ultraviolet light-protective color" means both "color and composition," thereby improperly distorting the meaning of the term "color." Such a distorted definition is not permissible and renders claim 1 indefinite. See In re Barr, 444 F.2d 588, 597, 170 USPQ 330, 338 (CCPA 1971) and In re Hill, 161 F.2d 367, 369, 73 USPQ 482, 484 (CCPA 1947).

For the foregoing reasons we will sustain the examiner's rejection of claims 1 through 8 under the second paragraph of § 112. However, to the extent that the claim language is understandable, we will not sustain the examiner's § 103 rejection of the appealed claims based on the combined teachings of Fouss and Prassas.

The Fouss reference discloses a corrugated pipe having inner and outer plastic layers. The inner layer contains carbon black to inhibit degradation due to ultraviolet radiation, and the outer layer contains titanium dioxide to provide the pipe with a white, light reflective exterior surface. The examiner concedes that Fouss's two-layer pipe construction differs from appellant's claimed invention in that Fouss's light-reflective layer is on the exterior of the pipe rather than the interior of the pipe. He nevertheless contends that the teachings of Prassas would have made it obvious to reverse the order of Fouss's plastic layers. We disagree.

Prassas discloses a porous pipe in which a single layer wall is formed from rubber particles 14 coated with a film of binder resin 18. According to Prassas's teachings, the film of binder resin contains carbon black 24 to inhibit degradation due to ultraviolet light. Such a teaching does not amount to a suggestion of placing Fouss's light-reflective layer on the inside of the pipe or of interiorly lining Fouss's pipe with a light-reflective layer. Furthermore, Fouss expressly teaches that the light-reflective layer should be on the exterior of

the pipe to keep the pipe from softening due to heat from the sun (see column 4, lines 46-52).

Moreover, even if Fouss's pipe were modified in the manner proposed by the examiner, the resulting structure would not arrive at the claimed invention in that Fouss's pipe is a corrugated pipe, not a helical pipe as recited in claim 1. The recitation that the pipe is a helical pipe in the preamble of claim 1 is not a statement of intended use of the pipe. Instead, it is a statement of particular pipe construction as specifically defined on page 3 of appellant's specification.

For the foregoing reasons, we must reverse the § 103 rejection of claims 1 through 8 and 15.

Under the provisions of 37 CFR 1.196(b), the following new ground of rejection is entered against claim 15:

Claim 15 is rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention. This claim is indirectly dependent from claim 1 and therefore encompasses the subject matter of claim 1. It is therefore indefinite for the reasons stated supra with respect to claim 1.

Appeal No. 98-0057  
Application No. 08/320,016

The examiner's decision rejecting the appealed claims is affirmed-in-part, and a new ground of rejection has been entered against claim 15 under the provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new



Appeal No. 98-0057  
Application No. 08/320,016

ground of rejection to avoid termination of proceedings (37  
CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the  
claims so rejected or a showing of facts relating to  
the claims so rejected, or both, and have the matter  
reconsidered by the examiner, in which event the  
application will be remanded to the examiner. . . .

(2) Request that the application be reheard  
under § 1.197(b) by the Board of Patent Appeals and  
Interferences upon the same record. . . .

Should the appellant elect to prosecute further before  
the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in  
order to preserve the right to seek review under 35 U.S.C. §§  
141 or 145 with respect to the affirmed rejection, the  
effective date of the affirmance is deferred until conclusion  
of the prosecution before the examiner unless, as a mere  
incident to the limited prosecution, the affirmed rejection is  
overcome.

If the appellant elects prosecution before the examiner  
and this does not result in allowance of the application,  
abandonment or a second appeal, this case should be returned  
to the Board of Patent Appeals and Interferences for final  
action on the affirmed rejection, including any timely request  
for rehearing thereof.

Appeal No. 98-0057  
Application No. 08/320,016

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

**AFFIRMED-IN-PART, 1.196(b)**

HARRISON E. McCANDLISH, Senior	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
IRWIN CHARLES COHEN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

bae

Appeal No. 98-0057  
Application No. 08/320,016

Richmond, Phillips, Hitchcock & Fish  
P.O. Box 2443  
Bartlesville, OK 74005